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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/800,280	03/12/2004	Thomas S. Neal	200314060-1	1301
22879 7590 06/25/2007 HEWLETT PACKARD COMPANY P O BOX 272400, 3404 E. HARMONY ROAD INTELLECTUAL PROPERTY ADMINISTRATION FORT COLLINS, CO 80527-2400			EXAMINER WRIGHT, INGRID D	
			ART UNIT 2835	PAPER NUMBER
			MAIL DATE 06/25/2007	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

36

Office Action Summary	Application No.		Applicant(s)	
	10/800,280		NEAL ET AL.	
	Examiner		Art Unit	
	Ingrid Wright		2835	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 May 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-14 and 16-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14, 16-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Allowable Subject Matter

1. The indicated allowability of claim 13 is withdrawn in view of the newly discovered reference(s) to Marsilio et al. US 6799677 B2. Rejections based on the newly cited reference(s) follow.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-3 & 6-12 are rejected under 35 U.S.C. 102(b) as being anticipated by US Kaminski US 5400902.

Note: Figs. 2,3 & 5 of Kaminski, presented in the Office Action, dated 4/24/06, still holds and represents claimed limitations, in the instant application.

Claim 1, Kaminski teaches a post (36), for retaining an item (31) in a storage compartment (20), having a side (e.g. sides of compartment (20) is not labeled, but shown in fig. 1 of Kaminski), the post (36) comprising: a body (e.g., body of (36)) operable to hold the item (31); and a coupling element (34) operable to couple the body to the side of the storage compartment (20) and to allow the post (36) to be moved to a position (e.g. position #1 is shown by solid lines of (36), in fig. 5 of Kaminski) in which the body can receive an item (31) to be stored in the compartment, and to a different position (e.g. position #2 is shown by dashed lines of (36), in fig. 5 of Kaminski), in which a bottom surface of a finger (54) of the body can not receive (i.e., receive as defined by Webster: to support the weight or pressure of) an item (31) to be stored in the compartment (20), in the second position.

Citation only: Official Notice is taken in regards to a body being moved to a second position in which, the body can not receive an item to be stored in compartment. Pettigrew et al. teaches a body, moved to a second position (e.g. position of (body (10) as shown in fig. 3B of Pettigrew et al.), in which portions (11) the body (10) can not receive (i.e. body (10) can not support the weight or pressure of) an item (12), to be stored in a base (1) of a compartment.

Claim 2, Kaminski, teaches wherein the body (e.g., body of (36)) is releasably fastened (via a button (32)) to the side of the storage compartment (20).

Claim 3, Kaminski teaches a body (e.g., body of (36)), pivotable relative to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski) of the storage compartment (20).

Claim 6, Kaminski teaches the coupling element (34), which includes a protrusion (62) insertable into a hole (e.g. area of lower cover insert receptacle (28)).

Claim 7, Kaminski teaches the coupling element (34) includes a protrusion (62) extending from the body (e.g., body of (36)), and a hole (e.g. area of lower cover insert receptacle (28)) in the side of the storage compartment (20) operable to receive the protrusion (62).

Claim 8, Kaminski teaches wherein the item (31) to be stored in the storage compartment (20) includes a disc (31) having a hole (76), and the body (e.g., body of (36)) is insertable into the hole (76).

Claim 9, Kaminski teaches wherein the item (31) to be stored in the storage compartment (20) includes a storage disc (31) having a hole, and the body (e.g., body of (36)) is insertable into the hole and includes a shoulder (50) to support the storage disc (31) away from the side (e.g. side of compartment (20)).

Claim 10, Kaminski teaches the body (e.g., body of (36)) which includes a first component (e.g., two bodies (36), as shown on fig. 5 of Kaminski) and a second component (e.g., two bodies (36) as shown on fig. 5 of Kaminski), and the coupling element (34) includes: a first element operable (34) to couple the first component to the side of the storage compartment (20) and to allow the first component to be positioned relative to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski)

in at least two different positions (e.g. positions shown in fig. 5 of Kaminski), and a second element operable (34) to couple the second component to the side (e.g. sides of compartment is not labeled, but shown in fig. 1 of Kaminski) of the storage (20) and to allow the second component to be positioned relative to the side in at least two different positions.

Claim 11, Kaminski teaches a storage compartment (20) comprising a bottom and a sidewall (e.g. sidewalls are unlabeled, but shown in fig. 5 of Kaminski) that define an interior, and a post (36) operable to retain a storage disc (31), and including a body (e.g. body of (36)) operable to engage the storage disc and a coupling element (34) operable to couple the body to the bottom of the storage compartment (20) and to allow the body to be positioned relative to the bottom in at least two different positions that include a position (e.g. position#1 shown by solid lines of the body of (36)) of the body in which the body can receive the storage disc (31) when the disc is stored in the compartment, and a position (e.g. position#2 shown by dashed lines of the body of (36)) in fig. 5 of Kaminski) in which the body can not receive the storage disc (31) when the disc is stored in the compartment (20).

Claim 12, Kaminski teaches wherein in one position (e.g. position of body (36) in fig. 5 of Kaminski) the body extends from the bottom into the interior substantially perpendicular to the bottom (e.g. extended perpendicular position shown by body of (36) in fig. 5 of Kaminski).

3. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smeege, Jr. et al. US 6535379 B1 in view of Kaminski US 5400902.

Claim 21, Smeege, Jr. et al. teaches a computer system (10) comprising a housing (20) having a storage compartment (col. 3, lines 30-35 of Smeege et al.) to retain an item (CD,DVD) and including: a bottom (bottom surface shown in fig. 2 of Smeege et al.) and a sidewall (side surface shown in fig. 2 of Smeege et al.) that define an interior (shown by recess of fig. 2 of Smeege et al.), and a post (44) operable to retain a storage disc (col. 3, lines 30-35 of Smeege et al.), and having: a body (see, body of (44)) operable to engage the storage disc and a processor (inherent) disposed in the housing (20), but is silent as to a

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coupling element operable to couple the body (e.g. body of (44)) to an interior of the storage compartment and a position in which the body can not receive the storage when the disc is stored in the compartment (20). Kaminiski teaches a system for retaining an item (31), which allows a body (see, body of components (36)) to be pivoted (see, two different positions of fig. 5 of Kaminski) and a coupling element (34) operable to couple the body (see, body of components (36)) of a storage compartment (20) and a position (e.g. position#2 as shown by dashed lines of the body of (36) in fig. 5 of Kaminski) in which the body (e.g. body of (36)) can not receive the storage disc when the disc (31) is stored in the compartment (20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the body and coupling element as taught by Kaminski in the invention of Smeege et al., in order to provide a control and enhanced grip system for the disc to engage the post (44) of Smeege, Jr. et al.

4. Claims 5, 13,14,16-20 & 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski US 5400902 in view of Marsilio et al. US 6799677 B2.

Claim 5, in regards to all the limitations of claim 1 above, Kaminski teaches wherein the position (e.g. position #1 of the body of (36) as shown in fig. 5 of Kaminski) in which the body (e.g. body of (36)) receives an item (31) stored in the compartment (20) includes the body substantially perpendicular to the side, and a position (e.g. position#2 as shown by dashed lines of the body of (36) in fig. 5 of Kaminski) in which the body does not receive an item (31) stored in the compartment (20) is somewhat parallel with the side, but is silent as to the body being substantially parallel with the side, in the position in which the body does not receive an item (12). Marsilio et al. teaches lowering a body of post (32) (col. 5, lines 44-50 of Marsilio et al.), substantially near a side of a storage compartment (200), in order to provide additional storage space and prevent interference with a disc holding page (206) containing additional hubs, but is silent as to a position of the post being substantially parallel with the side of the compartment (200). It would have been obvious to one having ordinary skill in the art at the time the invention was

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made to utilize a configuration, in which the body of the post (36) are substantially parallel with the side, in order to provide additional space within the compartment (20) of Kaminski, to receive a disk page, commonly found in many disk containers or cases.

Claim 13, in regards to all the limitations of claim 11 above, Kaminsk is silent as to one position of the body being disposed in a receptacle of the bottom, below a surface of the bottom. Marsilio et al. teaches a post (100), and a position in which a body (e.g. body of (100)) is disposed in a receptacle of a bottom (e.g. (post (100) are shown in a recess of a bottom surface, in fig. 8 of Marsilio et al.), below a surface of the bottom, in order to prevent an item such as a disk from flexing while the disk is being removed (col. 1, lines of Marsilio et al.). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the configuration of Marsilioet al., over the configuration of Kaminski, in order to provide an enhanced means of preventing a user from flexing and damaging the item (31) when removing the item from the storage compartment (20) of Kaminski. Further, one would be motivated to combine the art of Kaminski with Marsilio et al., since each invention utilizes push button retainers or hubs, for removing a disc.

Regarding the method claims 14 & 16-20, the method steps recited in the claims are inherently necessitated by the device structure as taught by Kaminski & Marsilio et al.. Kaminski & Marsilio et al. disclosed a method for storing a storage disc, the method comprising a body (body of (36)) of a post (36) positioned relative to a side of a storage compartment (20), from a position in which the body can not receive the storage disc (31) when the disc is stored in the compartment (20), to a different position (e.g. position#1 as shown by solid lines of the body of (36) in fig. 5 of Kaminski) in which the body can receive the storage disc (31) when the disc is stored in the compartment, and engaging a hole (76) in the disc (31) with the body, wherein the body is retained in the position, wherein the disc (31) is supported away from the side, wherein the hole (76) is disengaged in the disc from the body, the body is positioned relative to the side, to the position (e.g. position#2 shown by dashed lines of the body of (36)) in which

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the body can not receive the disc (31) when the disc is stored in the compartment and another item is placed in the storage compartment (20), wherein the body is positioned relative to the side includes the post (36) pivoted relative to the side, wherein the body (e.g. body of (100)) is positioned relative to the side, includes the body (e.g. body of (100)) disposed below a surface (e.g. post (100) is shown in a recess below a surface of a bottom in fig. 8 of Marsilio et al.) of the side in a receptacle (200).

Claim 23, Kaminski teaches a storage compartment (20) comprising a bottom and a sidewall (e.g. bottom and sidewall of compartment (20) are not labeled, but shown in fig. 1 & 5 of Kaminski) that define an interior and a post (36) pivotable and operable to retain a storage disc (31), and including a body (e.g. body of (36)) operable to engage the storage disk (31) and a coupling element (34) operable to couple the body (e.g. body of (36)) to the bottom of the storage compartment (20) and to allow the body to positioned relative to the bottom in at least two different positions (e.g. position#1 & position #2 of the body of (36) is shown by solid and dashed lines in fig. 5 of Kaminski), but is but is silent as to wherein in one position the body (e.g. body of (36)) is disposed in a receptacle of the bottom, below a surface of the bottom. Marsilio et al. teaches a post (100), and a position in which a body (e.g. body of (100)) is disposed in a receptacle of a bottom (e.g. post (100) is shown in a recess of a bottom surface, in fig. 8 of Marsilio et al.), below a surface of the bottom, in order to prevent an item such as a disk from flexing while the item is being removed (col. 1, lines of Marsilio et al.). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the configuration of Marsilio et al., over the configuration of Kaminski, in order to provide an enhanced means of preventing a user from flexing and damaging the item (31) when removing from the storage compartment (20) of Kaminski. Further, one would be motivated to combine the art of Kaminski with Marsilio et al., since each invention utilizes push button retainers or hubs for removing a disc.

5. Claims 4 & 22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kaminski US 5400902.

Claim 4, Kaminski teaches the coupling element (34) and a locking element (78), operable to retain the body (e.g. body of (36)) in at least one of two positions, but is silent as to the coupling element (34) including the locking element (78). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a configuration, whereby the coupling element (34) includes a locking element, in order to provide a stronger and secure grip of the end portions (50) of the post (36) within the compartment (20).

Kaminski teaches a locking element (78) operable to retain the body (e.g., body of (36)) in two positions (e.g., position #1 & position #2 of the body of (36) is shown by the dashed and solid lines fig. 5 of Kaminski and a coupling element (34), but is silent as to the coupling element (34) including the locking element (78). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a configuration, whereby the coupling element includes the locking element, over the configuration of Kaminski, since it has been held that rearranging parts of an invention involves only routine skill in the art. In re Japiskse, 86 USPQ 70.

Claim 22, Kaminski teaches a post (36), for retaining an item in a storage compartment having a side (e.g. sides of compartment (20) are unlabeled, but are shown in fig. 1 & 5 of Kaminski) the post comprising a body (e.g. body of (36)) operable to hold the item (31) and a coupling element operable (34) to couple the body to the side of the storage compartment (20) and to allow the body (body of (36)) to be positioned relative to the side in at least two different positions, and a locking element (78), but is silent as to the coupling element (34) including a locking element. It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a configuration, whereby the coupling element (34) includes a locking element, in order to provide a stronger and secure grip of the end portions (50) of the post (36) within the compartment (20).

Kaminski teaches a locking element (78) operable to retain the body (e.g., body of (36)) in two positions (e.g., position #1 & position #2 of the body of (36) is shown by the dashed and solid lines fig. 5

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of Kaminski and a coupling element (34), but is silent as to the coupling element (34) including the locking element (78). It would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize a configuration, whereby the coupling element includes the locking element, over the configuration of Kaminski, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiskse*, 86 USPQ 70.

Response to Arguments

6. Applicant's arguments, filed 4/16/07 in view of RCE of 5/25/07, have been fully considered.

Re Applicant's argument wherein the prior art references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the post being moved to a second position as shown by dashed lines of fig. 2 of the instant application) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Re Applicant's argument, wherein the post (36) is not moved to a different position in which the body can not receive an item to be stored in the compartment, the Examiner respectfully disagrees and notes that Kaminski teaches a first position (e.g. position #1 is shown by solid lines of (36), in fig. 5 of Kaminski) and a second position (e.g. position #1 is shown by dashed lines of (36), in fig. 5 of Kaminski), different from the first position, in which body (e.g. body of (36)) can not receive an item to be stored in the compartment. In this position, the body (e.g. body of (36)) can not receive (i.e., receive as defined by Webster: to support the weight or pressure of) the disk or item (31).

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure: Hu 6732862 B1 shows the general state of the art regarding storage units for removable discs with hub or retainer configurations.

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8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ingrid Wright whose telephone number is (571)272-8392. The examiner can normally be reached on M-F. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jayprakash Gandhi can be reached on (571)272-2800, ext 35. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

IDW

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